

**REMARKS**

Reconsideration and allowance of the subject application are respectfully requested.

Claims 1-15 are all the claims pending in the application. In response to the Office Action, Applicant respectfully submits that the claims define patentable subject matter.

**I. Overview of the Office Action**

Claims 1, 3-10, and 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Status Muller (U.S. Patent Application Publication No. 2001/0032101) in view of Tsuchino (U.S. Patent No. 5,260,573). Claims 2, 11, and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Status Muller in view of Tsuchino and further in view of Deguchi et al. (U.S. Patent No. 6,133,984, hereafter “Deguchi”). Claim 12 remains rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Applicant respectfully traverses the prior art rejections.

**II. Rejection under 35 U.S.C. § 101**

Claim 12 stands rejected under 35 U.S.C. § 101 because it is allegedly directed to non-statutory subject matter. The Examiner now argues that:

Claim 12 defines an image recording medium embodying functional descriptive material. However, the claim does not define a computer readable medium or memory and is thus non-statutory for that reason (i.e., “When functionally descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized” - Guidelines Annex IV). That is, the scope of the presently

claimed image recording medium can range from paper on which the program is written, to a program simply contemplated and memorized by a person.<sup>1</sup>

Applicant finds the Examiner's position unclear. Claim 12 requires an image recording medium for recording image data as a visible image thereon. Claim 12, as well as the specification, would clearly indicate to one skilled in the art that the "image recording medium" is a sheet or paper for recording a visible image. The Examiner appears to read the claimed "image recording medium" on a computer readable medium. The claimed invention as disclosed in claim 12 does not require a computer readable recording medium on which is recorded a computer program for executing a particular function. Accordingly, Applicant respectfully submits that the § 101 rejection is clearly erroneous, and requests that the Examiner remove the § 101 rejection.

### **III. Prior Art Rejections**

#### **Analysis**

The Examiner uses the same combination of references to reject the claims, but provides a different designation of the primary reference and the secondary reference. Because the majority of the previously submitted arguments were directed to the impropriety of the combination of Statius Muller and Tsuchino, Applicant respectfully submits that reversing the order of the references does not change the fact that the rejection of the combination is not supportable.

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<sup>1</sup> Page 3 of the Office Action dated September 25, 2007.

The Examiner now alleges that Statius Muller discloses all of the features of independent claim 1 and analogous independent claims 7 and 12 except for the feature “recording at least attributes of the image recording medium itself on said image recording medium”, as recited in claim 1 and analogously recited in claims 7 and 12. The Examiner thus relies on Tsuchino to allegedly cure this deficiency. Applicant respectfully submits that claims 1, 7, and 12 would not have been rendered obvious in view of the cited references.

In the present rejection, just as in the prior rejection, the Examiner has not provided any supportable objective reasoning why one of ordinary skill in the art would have been motivated to modify Statius Muller in view of Tsuchino. The Examiner contends that it would have been obvious to have recorded attribute information about the recording medium on the recording medium as taught by Tsuchino on the recording medium of Statius Muller “in order to inform the user about any sensitivity unevenness the recording medium may have to allow a processor to compensate for it, thereby gaining a higher quality image”.<sup>2</sup> This stated rationale is flawed for at least the following reasons.

First, the management system as disclosed by Statius Muller is not concerned with obtaining a higher quality image, but merely teaches a system which allows users (such as physicians) to link, via identification codes, data sets which are related to each other in a particular manner (for example, data sets which pertain to the same patient (paragraph [0017])). When the physician views the X-ray image of a patient, and requires further information about

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<sup>2</sup> Page 4 of the office Action dated September 25, 2007.

that patient, linking means finds out whether the original data set is associated with other data sets and displays a list of all data sets associated with the original data set (paragraph [0017]).

Accordingly, there is no need in Statius Muller to determine the attributes of the medium on which the medical images are recorded, thus undermining the Examiner's basis for the combination.

Further, although Tsuchino appears to disclose recording data for compensating the sensitivity unevenness for each stimulation phosphor plate 5 onto a magnetic tape 21 (column 5, lines 43-51), the reason Tsuchino requires compensation upon digitization of the stored image stems from the fact that the image of Tsuchino is latent. Thus, defects within the phosphor recording medium and those produced by the recording generator must be corrected. If the image were visibly recorded (as in Statius Muller), such errors could be corrected without separate designation of the defects attributable to particular media or devices. In other words, to make the image of Tsuchino visible would obviate the need to provide separately, the attribute information. Thus the references teach away from their combination with each other.

The claimed invention records attribute information or example, dates and times of a recording medium onto the recording medium itself, so that for example, if the recording medium is returned from the user to the manufacturer, the manufacturer can clearly recognize the situation in which the image has been recorded. Accordingly, if the recording medium suffers a failure, the recording medium can be quickly processed based on the attribute information recorded on the recording medium (see page 18 of the original specification). This aspect of the instant invention is neither taught nor suggested by the cited references.

Further, the Examiner does not address how one of ordinary skill in the art would have been able to modify Muller in view of Tsuchino to produce the claimed invention since the Tsuchino system is based upon the storing of information pertaining to the sensitivity of a phosphor plate in an area of the phosphor plate, while Statius Muller relates to the printing of identification codes associated with data sets along with an image of the data sets on a recording medium. The references are directed to completely different objects such that there is no reason to combine or modify their teachings in view of each other.

For this reason, Applicant respectfully submits that the Examiner's §103 rejection of claim 1 and analogous independent claims 7 and 12 is improper.

With respect to claim 2 and analogous claim 11, in the previous Office Action dated March 26, 2007, the Examiner acknowledged that Statius Muller and Tsuchino do not teach or suggest the feature "wherein said image recording medium is removed from a package of a plurality of image recording mediums, and the image data is recorded as the visible image on the removed image recording medium, and wherein said attributes of the image recording medium comprises information indicated on at least said package", as recited in claim 2 and analogously recited in claim 11. The Examiner thus relied on Deguchi to cure this deficiency and cited column 5, lines 12-17 of Deguchi as allegedly disclosing this feature of the claims.

In the previous Amendment filed on June 26, 2007, we submitted that these cited portions of Deguchi merely disclose that when photographic paper is loaded into a magazine, the magazine is set on a channel that matches the paper. Bar codes provided on the outer bag of the photographic paper are read so that information of the type and size of paper may be stored in a memory. Nowhere does this cited portion (or any other portion) of Deguchi teach or suggest that

the recording medium is removed from a package of recording mediums, and the information including the attributes of the image recording medium comprises information indicated on the package as required by the claims.

In response, the Examiner asserts:

Deguchi et al. discloses in col. 5, lines 12-18 that the bar code providing information about the type of photosensitive material is located on the outer bag. Furthermore, in order for the recording medium to be used it must be taken out of its package. The claim does not require the entire (sic) to be placed in the printer.<sup>3</sup>

Applicant respectfully disagrees with the Examiner's position. The claimed invention requires that the attributes of the recording medium are recorded on the recording medium. Although Deguchi may disclose that information pertaining to the photosensitive material are stored in a bar code provided on the outer bag of the photosensitive material, there is no teaching or suggestion in Deguchi that this information may be recorded on the recording medium, as required by the claims.

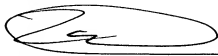
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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<sup>3</sup> Page 2 of the Office Action dated September 25, 2007

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mark E. Wallerson', enclosed within a large, loopy oval shape. A horizontal line extends from the right side of the signature.

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**23373**

CUSTOMER NUMBER

Date: December 26, 2007